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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Masaki Baba

050443

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EXAMINER

PEPITONE, MICHAEL F

ART UNIT

PAPER NUMBER

1767

MAIL DATE

DELIVERY MODE

03/30/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/541,746	<b>Applicant(s)</b> BABA ET AL.	
	<b>Examiner</b> MICHAEL PEPITONE	<b>Art Unit</b> 1767	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2011.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6,8-10,16-19 and 21-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,8-10,16-19 and 21-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Continued Examination Under 37 CFR 1.114**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/11 has been entered.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4, 9-10, and 16-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Watanabe et al. (US 2003/0125500).

Regarding claims 1-2, 4, 9-10, and 16-18: Watanabe et al. teaches an oxygen permeable soft lens (ex. C8; ¶ 191) comprising 25% of urethane compound of ex. B3 [prepared from a polydimethylsiloxane having hydroxyl groups at both ends and a degree of polymerization of 40 (DHDMSi-40), isophorone diisocyanate {IPDI}, and 2-hydroxyethyl acrylate {HEA} (¶ 150-

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159)], 25% of tris(trimethylsiloxy)silylpropylmethacrylate {TRIS}, 25% of N-methyl-3-methylene-2-pyrrolidone {MMP}, 25% of N,N-dimethylacrylamide {DMA}, 0.1% 2,4,6-trimethylbenzoyl-diphenylphosphineoxide {TPO}, and 0.1% ethyleneglycol dimethacrylate {EDMA}. After polymerization, the resulting lens was extracted into 2-propanol and the 2-propanol was subsequently replaced with saline (ex. C8; ¶ 188, 191).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents, in the claimed ranges, and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. an oxygen permeability coefficient ( $Dk$ ) of not less than  $51 \times 10^{-11}$  ( $\text{cm}^2/\text{sec}$ ), and a water content of 32 to 55 wt% [instant claim 1]; a tensile modulus of 0.2 to 8 MPa and a stress relaxation under loading a fixed load for 30 seconds is 8 to 15% [instant claim 10], would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

“Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) [see MPEP 2112.01].

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Claims 1-2, 4, 9-10, and 16-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe et al. (US 2003/0125500).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claims 1-2, 4, 9-10, and 16-18: Watanabe et al. teaches an oxygen permeable soft lens (ex. C8; ¶ 191) comprising 25% of urethane compound of ex. B3 [prepared from a polydimethylsiloxane having hydroxyl groups at both ends and a degree of polymerization of 40 (DHDMSi-40), isophorone diisocyanate {IPDI}, and 2-hydroxyethyl acrylate {HEA} (¶ 150-159)], 25% of tris(trimethylsiloxy)silylpropylmethacrylate {TRIS}, 25% of N-methyl-3-methylene-2-pyrrolidone {MMP}, 25% of N,N-dimethylacrylamide {DMA}, 0.1% 2,4,6-trimethylbenzoyl-diphenylphosphineoxide {TPO}, and 0.1% ethyleneglycol dimethacrylate {EDMA}. After polymerization, the resulting lens was extracted into 2-propanol and the 2-propanol was subsequently replaced with saline (ex. C8; ¶ 188, 191).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents, in the claimed ranges, and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. an oxygen permeability coefficient (Dk) of not less than  $51 \times 10^{-11}$  (cm<sup>2</sup>/sec), and a water content of 32 to 55 wt% [instant claim 1]; a tensile modulus of 0.2 to 8

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MPa and a stress relaxation under loading a fixed load for 30 seconds is 8 to 15% [instant claim 10], would inherently be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

“Products of identical chemical composition can not have mutually exclusive properties.”

A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) [see MPEP 2112.01].

### **Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 6 and 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 1 above.

Regarding claims 6 and 8: Watanabe et al. teaches the basic claimed lens material [as set forth above with respect to claim 1]; wherein Watanabe et al. disclose N-methyl-3-methylene-2-pyrrolidone {MMP} (ex. C8; ¶ 82, 191).

Watanabe et al. does not disclose 1-methyl-5-methylene-2-pyrrolidone [instant claim 6], and 5-methyl-3-methylene-2-pyrrolidone [instant claim 8]. However, at the time of invention a person of ordinary skill in the art would have found it obvious to have combined 1-methyl-5-methylene-2-pyrrolidone [instant claim 6], and 5-methyl-3-methylene-2-pyrrolidone [instant claim 8], which are regioisomers of 1-methyl-3-methylene-2-bbpyrrolidone. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities. “An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skilled in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” In re Payne, 606 F.2d 303, 313, 203 USPQ 245, 254 (CCPA 1979) [see MPEP 2144.09].

Claims 19, 21-26, 33-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500).

Regarding claims 19, 21-22, 25-26, 33-35: Watanabe et al. teaches a method for preparing an oxygen permeable soft lens (ex. C8; ¶ 191), wherein 25% of urethane compound of

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ex. B3 [prepared from a polydimethylsiloxane having hydroxylgroups at both ends and a degree of polymerization of 40 (DHDMSi-40), isophorone diisocyanate {IPDI}, and 2-hydroxyethyl acrylate {HEA} (§ 150-159)], 25% of tris(trimethylsiloxy)silylpropylmethacrylate {TRIS}, 25% of N-methyl-3-methylene-2-pyrrolidone {MMP}, 25% of N,N-dimethylacrylamide {DMA}, 0.1% 2,4,6-trimethylbenzoyl-diphenylphosphineoxide {TPO}, 0.1% ethyleneglycol dimethacrylate {EDMA}, 0.1% 1-(4,6-diphenyl-1,3,5-triazine-2-yl)-5-(hexyloxy)phenol {DPTHP}, and 0.02% tetra-(4-methacrylamide) copper phthalocyanine {APMA} were mixed, placed in a mold, and irradiated with UV light. After polymerization, the resulting lens was extracted into 2-propanol and the 2-propanol was subsequently replaced with saline (ex. C8; § 188, 191). Watanabe et al. disclose plasma treatment of the lens {with oxygen, nitrogen, argon, helium, and mixtures thereof} as well as plasma polymerization with methane/air, and graft polymerization with hydrophilic monomer (§ 85).

Watanabe et al. does not specifically disclose plasma treatment of example C8. However, at the time of invention a person of ordinary skill in the art would have found it obvious to have performed plasma treatment of the lens {with oxygen, nitrogen, argon, helium, and mixtures thereof} as well as plasma polymerization with methane/air, and graft polymerization with hydrophilic monomers based on the invention of Watanabe et al., and would have been motivated to do so since Watanabe et al. suggests that the resulting lens can be subjected to surface modification such as plasma treatment (§ 85).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents, in the claimed ranges, and was prepared under similar conditions. Therefore, the claimed effects and



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physical properties, i.e. an oxygen permeability coefficient ( $Dk$ ) of not less than  $51 \times 10^{-11}$  ( $\text{cm}^2/\text{sec}$ )), and a water content of 32 to 55 wt% [instant claim 19], would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

“Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) [see MPEP 2112.01].

Regarding claims 23-24: Watanabe et al. teaches solvents {ex. 2-propanol} (§ 80-81, 188).

Watanabe et al. does not specifically disclose 0.1 to 5 wt% of solvents. However, it has been well established that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) [MPEP 2144.05]. At the time of invention a person of ordinary skill in the art would have found it obvious to have optimized the amount of solvent, as taught by Watanabe et al., as commonly practiced in the art, and would have been motivated to do so since the degree of polymerization and the lens swelling ratio is influenced by the amount of solvent.

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Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 26 above, and further in view of Valiant, JR. et al. (US 2002/0102415).

Regarding claim 27: Watanabe et al. renders the basic claimed method obvious [as set forth above with respect to claim 26].

Watanabe et al. does not teach a plasma treatment with a mixture of oxygen and water [instant claim 27]. However, Valiant, JR. et al. teaches a method for surface treating contact lens material comprising a plasma treatment with a mixture of oxygen and water {air drawn through 5% hydrogen peroxide solution} [instant claim 27] (§ 10, 58). Watanabe et al. and Valiant, JR. et al. are analogous art because they are concerned with a similar technical difficulty, namely plasma treatment of contact lenses. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined plasma treatments in the presence of oxygen and water, as taught by Valiant, JR. et al. in the invention of Watanabe et al., and would have been motivated to do so since Valiant, JR. et al. suggests that such strong oxidizing plasma promote adhesion for bonding of the subsequent carbon deposition layer (§ 58).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 26 above, and further in view of Hayashi et al. (US 6,503,632).

Regarding claim 28: Watanabe et al. renders the basic claimed method obvious [as set forth above with respect to claim 26].

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Watanabe et al. does not teach a plasma treatment with a mixture of oxygen and tetrafluoromethane [instant claim 28]. However, Hayashi et al. teaches a method for surface treating contact lens material comprising a plasma treatment with a mixture of oxygen and tetrafluoromethane [instant claim 28] (1:10-18; 21:7-15). Watanabe et al. and Hayashi et al. are analogous art because they are concerned with a similar technical difficulty, namely plasma treatment of contact lenses. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined plasma treatments in the presence of oxygen and tetrafluoromethane, as taught by Hayashi et al. in the invention of Watanabe et al., and would have been motivated to do so since Hayashi et al. suggests that such plasma treatment provide a substrate with substituents which a chemical reaction can proceed {the surface of the molded article may be chemically bonded further with a polymer or monomer} (21:16-23).

Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 26 above, and further in view of Walther et al. (US 6,379,004).

Regarding claims 29-30: Watanabe et al. renders the basic claimed method obvious [as set forth above with respect to claim 26].

Watanabe et al. does not teach a plasma treatment with a mixture of oxygen and organic silane [instant claim 29], specifically tetramethoxysilane [instant claim 30]. However, Walther et al. teaches a method for surface treating ophthalmic lens material comprising a plasma treatment with a mixture of oxygen and tetramethoxysilane [instant claims 29-30] (1:4-6; 10:48-62). Watanabe et al. and Walther et al. are analogous art because they are concerned with a

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similar technical difficulty, namely plasma treatment of ophthalmic lenses. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined plasma treatments in the presence of oxygen and tetramethoxysilane, as taught by Walther et al. in the invention of Watanabe et al., and would have been motivated to do so since Walther et al. suggests that such plasma treatment provide a substrate with both an interface layer and a grease protection layer (10:48-50).

Claims 31-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 26 above, and further in view of Turek et al. (US 2002/0137811).

Regarding claims 31-35: Watanabe et al. renders the basic claimed method obvious [as set forth above with respect to claim 26].

Watanabe et al. does not teach a plasma treatment with a mixture of oxygen and methane [instant claim 31], and a mixture of oxygen, nitrogen, and methane [instant claim 32]. Watanabe et al. does not teach a surface treatment that is a coating method of a hydrophilic polymer coating [instant claim 33], specifically plasma polymerization of hydrophilic monomers [instant claim 34], and plasma-induced graft polymerizations [instant claim 35]. However, Turek et al. teaches a method for surface treating ophthalmic lens material comprising a plasma treatment with a mixture of oxygen and methane [instant claim 31], and a mixture of air {oxygen and nitrogen} and methane [instant claim 32] (§105-110). Turek et al. also teaches a method for surface treating ophthalmic lens material comprising a plasma treatment coating method of a hydrophilic polymer coating [instant claim 33], specifically plasma polymerization of

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hydrophilic monomers [instant claim 34], and plasma-induced graft polymerizations [instant claim 35] (§§105-110). Watanabe et al. and Turek et al. are analogous art because they are concerned with a similar technical difficulty, namely the surface treating of ophthalmic lenses. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined plasma treatments in the presence of air and methane, and plasma induced polymerizations, as taught by Turek et al. in the invention of Watanabe et al., and would have been motivated to do so since Turek et al. suggests that such plasma treatments provide a surface which is more ophthalmically compatible (§§ 106).

Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500), as applied to claim 19 above, and further in view of Niwa et al. (US 5,516,467).

Regarding claim 36: Watanabe et al. renders the basic claimed method obvious [as set forth above with respect to claim 19].

Watanabe et al. does not teach a method of coloring the ocular lens material by using a vat dye [instant claim 36]. However, Niwa et al. teaches a method for coloring contact lenses by using a vat dye [instant claim 36] (1:4-8; 2:26-49). Watanabe et al. and Niwa et al. are analogous art because they are concerned with a similar technical difficulty, namely the coloring of contact lenses. At the time of invention a person of ordinary skill in the art would have found it obvious to have combined vat dyes, as taught by Niwa et al. in the invention of Watanabe et al., and would have been motivated to do so since Niwa et al. suggests that such vat dyes can be uniformly dispersed in the monomer mixture (2:64-3:10; 3:30-40).

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe et al. (US 2003/0125500).

Regarding claim 37: Watanabe et al. teaches a method for preparing an oxygen permeable soft lens (ex. C8; ¶ 191), wherein 25% of urethane compound of ex. B3 [prepared from a polydimethylsiloxane having hydroxyl groups at both ends and a degree of polymerization of 40 (DHDMSi-40), isophorone diisocyanate {IPDI}, and 2-hydroxyethyl acrylate {HEA} (¶ 150-159)], 25% of tris(trimethylsiloxy)silylpropylmethacrylate {TRIS}, 25% of N-methyl-3-methylene-2-pyrrolidone {MMP}, 25% of N,N-dimethylacrylamide {DMA}, 0.1% 2,4,6-trimethylbenzoyl-diphenylphosphineoxide {TPO}, 0.1% ethyleneglycol dimethacrylate {EDMA}, 0.1% 1-(4,6-diphenyl-1,3,5-triazine-2-yl)-5-(hexyloxy)phenol {DPHP}, and 0.02% tetra-(4-methacrylamide) copper phthalocyanine {APMA} were mixed, placed in a mold, and irradiated with UV light. After polymerization, the resulting lens was extracted into 2-propanol and the 2-propanol was subsequently replaced with saline (ex. C8; ¶ 188, 191). Watanabe et al. disclose plasma treatment of the lens {with oxygen, nitrogen, argon, helium, and mixtures thereof} as well as plasma polymerization with methane/air, and graft polymerization with hydrophilic monomer (¶ 85).

Watanabe et al. does not specifically disclose plasma treatment of example C8. However, at the time of invention a person of ordinary skill in the art would have found it obvious to have performed plasma treatment of the lens {with oxygen, nitrogen, argon, helium, and mixtures thereof} as well as plasma polymerization with methane/air, and graft polymerization with hydrophilic monomers based on the invention of Watanabe et al., and would have been

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motivated to do so since Watanabe et al. suggests that the resulting lens can be subjected to surface modification such as plasma treatment (§ 85).

The Office realizes that all the claimed effects or physical properties are not positively stated by the reference. However, the reference teaches all of the claimed reagents, in the claimed ranges, and was prepared under similar conditions. Therefore, the claimed effects and physical properties, i.e. an oxygen permeability coefficient ( $Dk$ ) of not less than  $51 \times 10^{-11}$  ( $\text{cm}^2/\text{sec}$ ), and a water content of 32 to 55 wt% [instant claim 37], would implicitly be achieved by a composition with all the claimed ingredients. If it is the applicants' position that this would not be the case: (1) evidence would need to be presented to support applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties and effects with only the claimed ingredients.

"Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990) [see MPEP 2112.01].

### **Response to Arguments**

Applicant's arguments with respect to claims 1-2, 4, 6, 8-10, 16-19, and 21-37 have been considered but are moot in view of the new ground(s) of rejection.

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Valiant, JR. et al. (US 2002/0102415) was relied on for disclosing a method for surface treating contact lens material comprising a plasma treatment with a mixture of oxygen and water {air drawn through 5% hydrogen peroxide solution} (§ 10, 58).

Hayashi et al. (US 6,503,632) was relied on for disclosing a method for surface treating contact lens material comprising a plasma treatment with a mixture of oxygen and tetrafluoromethane (1:10-18; 21:7-15).

Walther et al. (US 6,379,004) was relied on for disclosing method for surface treating ophthalmic lens material comprising a plasma treatment with a mixture of oxygen and tetramethoxysilane (1:4-6; 10:48-62).

Turek et al. (US 2002/0137811) was relied on for disclosing a method for surface treating ophthalmic lens material comprising a plasma treatment with a mixture of oxygen and methane, and a mixture of air {oxygen and nitrogen} and methane (§105-110).

Niwa et al. (US 5,516,467) was relied on for disclosing a method for coloring contact lenses by using a vat dye (1:4-8; 2:26-49).

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pepitone whose telephone number is 571-270-3299. The examiner can normally be reached on M-F, 7:30-5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on 571-272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MFP  
24-March-11

/Mark Eashoo/

Supervisory Patent Examiner, Art Unit 1767